

## **REMARKS**

Claims 1 – 17 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, the Examiner objected to claims 7, 10, 12, and 15 for containing terms which render the claims indefinite; objected to claim 15 for informalities; rejected claims 1, 2, 6, and 12-15 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,273,393 to McCoy (hereafter referred to as “McCoy”); rejected claims 6-11 under 35 U.S.C. §103(a) as being unpatentable over McCoy; and indicated that claims 4 and 5 would be allowable if rewritten in independent form.

By this Response, Applicant has amended claims 7, 10, 12, and 15 to remove terms that render the claims indefinite, and have introduced new claims 16 and 17 to include language removed from claims 7 and 12.

It is respectfully submitted that no new matter within the meaning of 35 U.S.C. §132 has been introduced to this application.

### **Objections to the Claims**

The Examiner objected to claims 7 and 12 for containing the phrase “beams and/or channels” which renders the claim indefinite; objected to claims 10 and 15 for containing the phrase “can be” which renders the claim indefinite; and objected to claim 15 for an informality.

### **Response**

By this Response, Applicant has replaced the phrase “beams and/or channels” in claims 7 and 12 with the phrase “beams” and has added new claims 16 and 17 to recite the phrase “channels” as cancelled from claims 7 and 12. Support for this amendment may be found in the claims as originally filed.

Applicant submits that claims 7 and 12, and newly added claims 16 and 17, are now in condition for allowance.

Further, by this response, Applicant has replaced the phrase “can be extended using modular extension mould” in claims 10 and 15 with the phrase “is extended using a modular extension mould.”

Applicant submits that claims 10 and 15 are now in condition for allowance.

Applicant submits that the objection to claim 15 has been obviated by the aforementioned amendments.

In view of the aforementioned amendments, Applicant respectfully requests that the Examiner withdraw the objections to claims 7, 10, 12, and 15, and allow newly added claims 16 and 17.

#### **Rejection under 35 U.S.C. §102(b)**

The Examiner rejected claims 1, 2, 6, and 12 – 15 under 35 U.S.C. §102(b) as being anticipated by McCoy.

#### **Response**

Reconsideration and withdrawal of the rejections are respectfully requested.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Independent claim 1 recites a formwork system for use in casting prefabricated panels. The system includes, *inter alia*, “a support structure including a platform defining a surface of the panel to be

cast, and a sub-structure supporting the platform” and “a plurality of side forms *being positionable on the platform to define sides of the panel to be cast*” (Present application, claim 1, emphasis added).

McCoy is drawn to a concrete form support bracket and assembly which can be used to pour concrete bridge decks or building floors. In McCoy, support assemblies *descend* from longitudinal bridge beams. (See McCoy, Fig. 5) Specifically, a bolt 18 hangs a bracket 54 below a beam 47 (McCoy, col. 3, lines 66 – 67). The brackets in turn support ledgers 32, on top of which a plywood deck 16 is placed. The concrete bridge deck is poured over top of this plywood deck (McCoy, col. 4, lines 7 – 10). Importantly, the concrete is poured over the beams and brackets; in fact, the top portions of the bracket remain permanently embedded in the concrete (McCoy, col. 4, lines 47 – 49).

McCoy fails to disclose, teach, or suggest “a plurality of side forms *being positionable on the platform to define sides of the panel to be cast*” (Present application, claim 1, emphasis added). The design of McCoy includes no side forms at all, and McCoy is completely silent on how the sides of the concrete deck are to be defined. The Examiner refers to element 12 in McCoy as “a plurality of side forms...positionable on the platform 16.” Applicant traverses this statement, and submits that element 12, presented in McCoy only as prior art, is in fact a ledger (see McCoy, column 3, lines 55 – 57: “laterally extending wood planks 12 (usually called ledgers or whalers), extending between adjacent pairs of longitudinal bridge beams 47”) whose purpose is to support an intermediate member which in turn supports the platform. This element is in fact placed *beneath* the platform 16 (see McCoy, Fig. 1 and Fig. 2). This ledger can by no means be considered a side form; it is incapable of “being positionable on the platform to define sides of the panel to be cast” as it is placed *beneath* the platform, and therefore not in contact with the panel in any way. The ledger supports the concrete from beneath the platform, and not from the side. In fact, *all* of the elements of McCoy’s support brackets and assembly, including ledger 32, are placed beneath the concrete layer to be formed. (McCoy, Fig. 4, Fig. 5, col. 4 ln.

21 – 58).

As McCoy contains no elements “positionable on the platform,” and is completely silent on how the sides of the concrete layer are defined, applicant submits that McCoy fails to disclose, teach, or suggest “a plurality of side forms being positionable on the platform to define sides of the panel to be cast.” (Present Application, claim 1). Further, as McCoy fails to disclose, teach, or suggest “side forms” in any manner, it cannot disclose, teach, or suggest “a strut extending from the side form” (Present Application, claim 2) or “a plurality of sets of side forms” (Present Application, claim 6).

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the outstanding rejection to independent claim 1, and to claims 2, 6, and 12 – 15, all of which depend from claim 1.

#### **Rejection under 35 U.S.C. §103(a)**

The Examiner rejected claims 6 – 11 under 35 U.S.C. §103(a) as being anticipated by McCoy.

#### **Response**

Reconsideration and withdrawal of the rejections are respectfully requested.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Applicant submits that all of the features of the presently claimed invention are not disclosed, taught or suggested in the cited prior art. As discussed above, McCoy fails to disclose, teach, or suggest “a plurality of side forms being positionable on the platform to define sides of the panel to be cast”

(Present Application, Claim 1). Accordingly, applicant submits that claim 1 is now in condition for allowance. As claims 6 – 11 depend from claim 1, applicant submits that these claims too are in condition for allowance.

Furthermore, claims 6 – 11 explicitly claim the features of “sets of side forms each set varying in height to permit casting of panels of varying thickness” (6 and 11), a “sub-structure [of] beams which provide support to the platform” (7), platforms and side forms “designed to impart a pattern onto the surface of the...panel” (8 and 9), and a formwork system “extended using a modular extension mould to prefabricate higher heights of wall panels” (10), and it is submitted that it could not be obvious to modify McCoy to include these features at least because there is no teaching to do so.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the outstanding rejections to claims 6 – 11.

#### **Allowable subject matter**

The Examiner objected to claims 4 and 5 as dependent from rejected base claim 1, but indicated that claims 4 and 5 would be allowable if rewritten in independent form.

#### **Response**

As applicant submits that claim 1 is now in condition for allowance, applicant requests that the Examiner reconsider and withdraw the objections to claims 4 and 5.

Applicant notes that claim 3 was not directly rejected in the outstanding Office Action. Applicant submits that claim 3, which depends from claim 1, is in condition for allowance for at least the reasons given above. Applicant also notes that claim 3 discloses “a threaded bore associated with the abutment and a threaded shaft forming at least in part the strut which is received by the threaded bore,” which is not disclosed, taught, or suggested in McCoy. Applicant respectfully requests that the

Examiner reconsider and withdraw any objections or rejections to claim 3.

## CONCLUSION

In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

Date: Feb 28, 2006  
NATH & ASSOCIATES PLLC  
112 South West Street  
Alexandria, VA 22314  
(703) 548-6284

  
Harold L. Novick  
Registration No. 26,011